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| EXAMINER |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on *07 October 2008*.

2a)☐ This action is **FINAL**.  2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *1,2,4-9,11-16 and 18-20* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-9,11-16 and 18-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All  b)☐ Some *  c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

## DETAILED ACTION

### Claim Rejections - 35 USC § 112

1.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.      **Claims 15 – 20** are rejected under 35 U.S.C. 112, second paragraph, because it

is uncertain how the system is performing the various claimed functions.  Specifically,

the Examiner asserts that the applicant has failed to provide the necessary structural

components that perform the various processes of the disclosed claims.  Moreover, the

applicant has also claimed:

> "...a processor for determining whether the user is due a purchase price
>
> protection refund based on the current total purchase price on the second web
>
> site..."

However, the Examiner is uncertain how a processor can determine the above

mentioned process.  That is to say, the Examiner asserts that a processor by itself

without any accompanying hardware is unable to determine whether the user is due a

purchase price protection refund based on the current total purchase price on the

second web site.  The determination of this step would be requested by a software

program and executed by the processor.  Even still, the processor itself would not be

able to execute the determination alone.

3.      In regards to **claim 20**, the Examiner is uncertain as to how the entire refund is

sent directly to the user.  That is to say, **claim 15** clearly claims that the refund is

divided into at least two portions, wherein one portion is sent directly to the user and the

remainder of the refund as a fee associated with the user. Consequently, the Examiner

asserts that the entire refund can never be sent directly to the customer since at least

one portion of the entire refund is used to pay for fees associated with the user.

Moreover, as currently disclosed by **claim 20** one of ordinary skill in the art would have

also understood that the transmitter is also sending another refund on top of the portion

of the refund that was sent as disclosed by **claim 15**. As a result, it is uncertain whether

**claim 20** is sending another refund.

### *Claim Rejections - 35 USC § 101*

4.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

5.      **Claims 1 – 7** are rejected under 35 U.S.C. 101 because based on Supreme

Court precedent, and recent Federal Circuit decisions, the Office's guidance to

examiner is that a § 101 process must (1) be tied to another statutory class (such as a

particular apparatus) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981);

Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70

(1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process

would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory

process, the claim should recite the other statutory class (the thing or product) to which

it is tied, for example by identifying the apparatus that accomplishes the method steps,

or positively recite the subject matter that is being transformed, for example by
identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit
decision since they are not tied to another statutory class and can be performed without
the use of a particular apparatus. Thus, **Claims 1 – 7** are non-statutory since they may
are not tied to another statutory class.

6.     **Claims 8 – 14** are rejected under 35 U.S.C. 101 because the applicant is
claiming a computer program product comprising computer instructions that is not
stored on a computer readable medium that when executed by a computer performs the
claimed instructions. As best understood by the Examiner from the applicant's
specification, the limitations set forth in the claims are directed to software and software,
per se, is not statutory.

7.     **Claims 15 – 20** are rejected under 35 U.S.C. 101 because the applicant is
claiming a system with no structural components. As best understood by the Examiner
from the applicant's specification, the limitations set forth in the claims are directed to
software and software, per se, is not statutory. Moreover, in regards to **claims 15 – 20**,
the Examiner notes that the applicant is claiming the system by what it does and not by
the structure to perform the claimed invention.

### *Claim Rejections - 35 USC § 103*

8.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.      **Claims 1 – 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McClung, III (US Patent 7,107,225 B1)** in view of **Thakur et al. (US PGPub 2002/0194069 A1)**.

10.      In regards to **claims 1, 8, and 15**, **McClung** discloses a method for offering purchase price protection for a product and/or service, the method comprising the steps of:

receiving, by a first web site, information directly from a user, the information being entered by the user at the first web site via a user interface at the first website, wherein the information is associated with a configuration of a product and/or service that was purchased by the user from a second web site different from the first web site, wherein the information includes a total purchase price of the product and/or service, and wherein the vendor offers purchase price protection for the purchased configuration of the product and/or service, wherein the user also enters a type of price protection offered by the second website, and wherein the user submits the information to the first web site by selecting a button on the user interface **(Col. 2 Lines 14 – 27, 53 – 56; Col. 4 Lines 8 – 30; Col. 5 Lines 41 – 54)**; **(Claim 8)** <u>the user also entering a notification type selection indicating how the user is to be notified of a refund from the purchase price protection</u> **(Col. 2 Lines 60 – 65 wherein the user can log on to the site to receive the notification or wait by having the host system contact the user using the providing contact information, if any information was ever provided. That is**

**to say, the system's default is to notify them through the web site unless another**

**method has been provided);**

initiating, by the first web site, the purchase price protection offered by the

second website as indicated by the user for the purchased configuration of the product

and/or service in response to the user selecting the button on the user interface **(Col. 2**

**Lines 14 – 27)**;

determining, by the first web site, a current total purchase price for the purchased

configuration of the product and/or service at the second web site, wherein the

determining includes accessing the second website by the first website and selecting

each configurable component of the purchased configuration of the product and/or

service to identify the current total purchase price the purchased product and/or service

configuration **(Column 2 Lines 19 – 23; see also explanation below regarding total**

**price = $\sum$ (price of the components))**;

determining, by the first web site, whether the user is entitled to a purchase price

protection refund based on the current total purchase price at the second web site

**(Column 1 Lines 39 – 45; Column 3 lines 17 – 22)**; and

the first web site sending directly to the user an indication **(Claim 8)** <u>based on the</u>

<u>notification type selection entered by the use</u> indicating that the user is entitled to the

purchase price protection refund indicating that the purchase price protection refund is

due **(Column 1 Lines 58 – 60; Column 3 Lines 17 – 22)**;

**(Claim 15)** <u>wherein the transmitter is further for sending a portion of the refund</u>

<u>directly to the user and keeping a remaining portion of the refund as a fee associated</u>

with the user **(Col. 1 Lines 47 – 52, 64 – 67; wherein it would have been obvious to one of ordinary skill in the art that the host system is in communication with the vendors and when a refund becomes available the host system will handle the making available of the refund to the customer and credit the amount to the customer's account and wherein it is common sense that business have an associated fee for carrying out said service)**.

**McClung** further discloses, in certain embodiments, an improvement for a method for generating vendor information including contacting a host system by a consumer identifying at least one vendor doing business in a pertinent geographic area and retrieving from the host system information related to the vendor.  The improvement including providing a method to guarantee to the consumer a better price or a best price on items or services purchased from the vendor for a predetermined time period following a transaction.

However, **McClung** fails to explicitly disclose:

wherein the configuration of the product and/or service includes a plurality of configurable components each associated with a different purchase price and wherein the total purchase price comprises the sum of each component's price; and

whether a consumer performed the purchase at the host system or at the vendor's web site.

Regarding the configuration of the product and/or service includes a plurality of configurable components each associated with a different purchase price and wherein the total purchase price comprises the sum of each components price the Examiner

asserts that one having ordinary skill in the art at the time the invention was made that

there are a variety of types of products, including products that are made of various

components. For example, it is extremely old and well known that computer system are

made of several components, such as video cards, motherboards, processors, hard

drives, and etc., and that each computer component has an associated price. In other

words, the total price of the computer system is dependent on the price of each

component that makes up the computer system.

 With that said, it would have also been obvious for one of ordinary skill in the art

looking upon the teachings of **McClung's** price guarantee that when determining the

current total purchase price for the purchased configuration would include accessing the

second website where the product was purchased and searching the current price of

each component in order to determine the total price.

 Therefore, it would have been obvious to one having ordinary skill in the art at

the time of the invention that a product and/or service can include a plurality of

configurable components each associated with a different purchase price and wherein

the total purchase price comprises the sum of each component's price.

 Regarding whether a consumer performed the purchase at the host system or at

the vendor's web site, **McClung** fully incorporates the patent application, "Business

System" by **Thakur et al.**, wherein **Thakur** discloses the communication system

between a host system, consumer, and vendor.

 **Thakur** discloses that a consumer makes an initial inquiry to the host system and

fills out a host system questionnaire. The host system can further keep a record of the

consumer's transactions with each vendor in its database including payments, discounts

refunds, and accounting transactions. As can be seen in **Fig. 1**, the consumer can

perform transactions directly with the vendor and provide any necessary information to

complete the host system questionnaire. The host system is also in communication

with the vendor and the consumer, as well. As a result, it would have been obvious for

a consumer to purchase a product from a vendor, provide the vendor information to the

host system, having the host system search for the vendor within the host system

database, and have the host system be in communication with the vendor in order to

monitor any transactions made between the vendor and the consumer **(See Fig. 1,**

**Page 5 – 6 ¶ 57, 61 – 64; Page 7 ¶ 74)**.

Therefore, it would have been obvious to one having ordinary skill in the art at

the time of the invention to modify **McClung** in view of the teachings of **Thakur** to

provide a system where a consumer can perform a transaction with a vendor, provide

the vendor information to a host system, and have the host system be in communication

with the vendor in order to monitor any transactions made between the vendor and

consumer in the event that a refund or discount is applicable.

11.     In regards to **claims 2, 9, and 16, McClung** discloses wherein the user interface

at the first web site includes a web page having a list of text fields and identifiers for the

user to enter at least one of the following information associated with a configuration of

a product and/or service that was purchased by the user from the second web site, the

user thereby providing information directly to the first web site **(Column 4 Lines 8 – 30;**

**see also explanation given in Response to Arguments)**:

a name of the product and/or service;

a description of the product or service;

an identifier of the product and/or service;

a name, address and telephone number of the second web site;

a date the product and/or service was purchased by the user; and

a total purchase price the user paid for the product and/or service.

12.     In regards to **claims 4, 11, and 18, McClung** discloses wherein the second

determining step comprises the steps of:

determining a time period of the purchase price protection offered by the second

web site for the purchased configuration of the product and/or service, the current time,

the total purchase price of the product and/or service configuration, and the current total

purchase price of the product and/or service configuration at the second web site

**(Column 4 Lines 8 – 30)**; and

if the current time is within the time period of the purchase price protection and

the purchase price of the product and/or service configuration is greater than the current

total purchase price at the second web site, then determining that the user is due a

purchase price protection refund **(Column 1 Lines 39 – 45)**; and

otherwise, determining that the user is not due a purchase price protection refund

**(obviously included)**.

13.     In regards to **claims 5, 12, and 19, McClung** discloses further comprising the

step of:

the first web site providing directly to the user with information necessary for

redeeming the refund that is due from the purchase price protection offered by the

second web site, such that the user may redeem the refund directly from the second

web site **(Columns 7 – 8  Lines 47 – 20)**.

14.     In regards to **claims 6, 13, and 20**, **McClung** discloses further comprising the

steps of:

the first web site sending directly to the user the entire refund corresponding to

the refund due from the purchase price protection offered by the second web site

**(Claim 6)**; and

the first web site redeeming from the second web site, on behalf of the user, the

refund the user is due from the purchase price protection offered by the second web site

**(Col. 1 Lines 47 – 52, 64 – 67; wherein it would have been obvious to one of**

**ordinary skill in the art that the host system is in communication with the vendors**

**and when a refund becomes available the host system will handle the making**

**available of the refund to the customer and credit the amount to the customer's**

**account)**.

15.     In regards to **claims 7 and 14**, **McClung** discloses wherein the first web site and

the second web site are separate e-commerce web sites **(Column 1 Lines 53 – 60;**

**Column 2 Lines 14 – 29)**.

### *Response to Arguments*

Applicant's arguments filed **10/7/08** have been fully considered but they are not

persuasive.

 **Argument toward amended subject matter**

16.     The remarks made toward the amended portions of the claims are not

persuasive and moot because they are based on amended language.  Specifically, the

remarks **starting at the bottom of page 14 of 22 to the first full paragraph of page**

**16 of 22 are moot**; **page 19 of 22 paragraphs 1 and 2**.

**Claim Objection**

17.     Objection toward **claim 20** has been withdrawn due to amendments.

**Rejection under 35 USC 112, second paragraph**

18.     Rejection under 35 USC 112, second paragraph, toward claim 15 has been

withdrawn due to amendments.

**Rejection under 35 USC 103**

19.     On **page 13 of 22** of applicant's remarks, the applicant states that **McClung**

merely states on **Col. 2 Lines 14 – 27 and 53 – 56**:

> "[...]
>
> In one aspect, the vendor (and/or host system or similar system) monitors
> competitors on a real time basis and provides the consumer at the
> vendor's location any better price available then at any competitor for the
> same item (or service
>
> [...]"

However, the Examiner would like to make it clear on the record that no such

quote was found within **McClung** and that the statement made above is only the

applicant's interpretation/summary of only part of what **McClung** discloses on **Col. 2**

**Lines 14 – 27 and 53 – 56**.

20.     On **pages 13 – 14 of 22** of applicant's remarks, the applicant reproduces **Col. 5**

**Lines 41 – 54** of **McClung**, but continues on **page 14 of 22** to argue that **Thakur**

teaches this and, as best understood by the Examiner, that **Thakur**, "... **does not**

include purchase information in order to receive coupons from the Host system.  The

host system in **Thakur** records transaction information from the vendor, not by the user

entering information.  Col. 5, lines 41-54 of **McClung** is merely stating that this system

of **Thakur** can also perform price guaranteeing operation, which would most likely be

performed automatically based on the teachings of **McClung** and **Thakur** without the

user entering any purchase transaction information, refund type information, or

purchase price protection information."

Again, the Examiner would like to make it clear on the record that the invention

as disclosed by **Thakur** is directed toward a different environment in which the system

can be used and that **McClung** is directed to an invention that uses the

infrastructure/components of **Thakur** in order to carryout the invention as disclosed by

**McClung** and wherein the combination of **McClung and Thakur** fully reads upon the

applicant's invention.  It appears to the Examiner that the applicant has recognized

another advantage which would flow naturally from following the suggestion of the prior

art cannot be the basis for patentability when the differences would otherwise be

obvious.  See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Moreover, it also appears that the applicant is arguing the references separately.

In response to applicant's arguments against the references individually, one cannot

show nonobviousness by attacking references individually where the rejections are

based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871

(CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As stated in the rejection above, the **combination of McClung and Thakur**, where

**McClung** discloses the use of **Thakur's** system/infrastructure for the implementation of

**McClung** invention, fully anticipates the applicant's instant invention.

21.     Applicant argues that **McClung** fails to teach, "...the user also entering a

notification type selection indicating how the user is to be notified of a refund from the

purchase price protection, and wherein the user submits the information to the first web

site by selecting a button on the user interface... sending directly to the user an

indication based on the notification type selection entered by the user indicating that the

user is entitled to the purchase price protection refund."

However, as discussed in the rejection above, **McClung** discloses that a user

can log onto the site to receive the notification or wait by having the host system contact

the user using the provided contact information.  In other words, **McClung** clearly

discloses that the system will notify a user when the user logs into the site.  However,

**McClung** further discloses that the user can be contacted through other means, such

as phone, fax, email, and/or interactive site, a consumer can be alerted to possible

warranty extensions and/or renewals and can apply for them **(McClung Col. 2 Lines 60

– 65)**.  Consequently, the Examiner asserts that one of ordinary skill in the art would

have realized that in order for a user to receive a notification by e-mail, for example, the

user **had** to have entered a notification type selection, e.g. e-mail.  As a result, it is

further asserted that **the combination of McClung and Thakur** does, indeed, disclose

a user entering a notification type selection indicating the various means of how the

user is to be notified of a refund form the purchase price protection.

22.     Applicant's traversal regarding the limitation disclosing, "...wherein the transmitter

is further for sending a portion of the refund directly to the user and keeping a remaining

portion of the refund as a fee associated with the user" wherein the Examiner stated,

**(Col. 1 Lines 47 – 52, 64 – 67)** wherein it would have been obvious to one of ordinary

skill in the art that the host system is in communication with the vendor and when a

refund becomes available the host system will handle the making available of the refund

to the consumer and credit the amount to the customer's account and wherein it is

common sense that business have an associated fee for carryout said service" is

insufficient.

A "traverse" is a denial of an opposing party's allegations of fact.   The Examiner

respectfully submits that applicants' arguments and comments do not appear to

traverse what Examiner regards as knowledge that would have been generally available

to one of ordinary skill in the art at the time the invention was made.  Even if one were

to interpret applicants' arguments and comments as constituting a traverse, applicants'

arguments and comments do not appear to constitute an adequate traverse because

applicant has not specifically pointed out the supposed errors in the examiner's action,

which would include stating why the noticed fact is not considered to be common

knowledge or well-known in the art.  27 CFR 1.104(d)(2), MPEP 707.07(a).  An

adequate traverse must contain adequate information or argument to create on its face

a reasonable doubt regarding the circumstances justifying Examiner's notice of what is

well known to one of ordinary skill in the art.  In re Boon, 439 F.2d 724, 728, 169 USPQ

231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during

examination, then the object of the well known statement is taken to be admitted prior

art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).  MPEP 2144.03

Reliance on Common Knowledge in the Art or "Well Known" Prior Art.  In view of

applicant's failure to adequately traverse, the following are admitted prior art:

> "...wherein the transmitter is further for sending a portion of the refund
> directly to the user and keeping a remaining portion of the refund as a fee
> associated with the user"

23.     Applicant states the following on **page 19 of 22**:

> "the Examiner provided **Thakur** as an additional teaching in order
> to show that the system used by **McClung**, which is the system found in
> **Thakur**, would have obviously allowed one having ordinary skill in the art
> that a consumer can perform a transaction with a vendor, provide the
> vendor information to a host system, and have the host system be in
> communication with the vendor in order to monitor any transactions made
> between the vendor and consumer in the event that a refund or discount is
> applicable.
> Moreover, the above claims recite combinations which only unite
> old elements with no change in their respective functions and which yield
> predictable results.  Thus, the claimed subject matter likely would have
> been obvious under KSR.  In addition, neither applicant's Specification nor
> applicant's arguments present any evidence that modifying **McClung** with
> the selected elements of **Thakur** was uniquely challenging or difficult for
> one of ordinary skill in the art.  Under those circumstances, the Examiner
> did not err in holding that it would have been obvious to one having
> ordinary skill in the art at the time of the invention was made to modify the
> combination of **McClung** with the teachings of **Thakur** to provide a system
> where a consumer can perform a transaction with a vendor, provide the
> vendor information to a host system, and have the host system be in
> communication with the vendor in order to monitor any transactions made
> between the vendor and consumer in the event that a refund or discount is
> applicable.  Because this is a case where the improvements are no more

than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396."

However, the Examiner would like to make it clear on the record that this was not

the full argument that was presented by the Examiner and that it was directed toward

the limitation which can be seen below:

"...receiving, by a first web site, information directly form a user, the information being entered by the user at the first web site via a user interface at the first website, wherein the information is associated with a product and/or service that was purchased by the user from a second web site different from the first web site, wherein the information includes the purchase price protection for the product and/or service, and wherein the user submits the information to the first web site by selecting a button on the user interface;..."

The Examiner responded with the following:

"In response to applicant's argument that "The system of Thakur merely teaches a system for providing future discounts such as coupons to a consumer **(Page 12 of 19 of Remarks)**" and that "Nowhere does Thakur teach or suggest that a consumer enters any information regarding a purchase," the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.  See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).
        Further still, the Examiner has already stated that **Thakur** was used to teach the system used in the method of **McClung**.  That is to say, **McClung** discloses using the system of **Thakur** to allow a user to use the host system after a purchase has been made **(Col. 1 Lines 39 – 45, 60 – 63; Col. 4 – 5 Lines 67 – 8; Figure 1)**.  **McClung** discloses that it is obvious that the consumer logs into the host system after a purchase is made from a vendor, which would obviously include purchases made from another web site, and provides the product information to the host system. All of which would require a button in order to allow the user to submit the inputted information.  The host system then monitors the price of the purchased item with the prices of other vendors and would then notify the consumer if a refund is available.

Although, the applicant argues that it appears that **Thakur** uses the system prior to a purchase or that the system is used for discounts or that it does not mention price protection the Examiner asserts that **Thakur** was not used to teach these limitations.    As discussed above, **McClung** teaches all of these limitations, but fails to teach how the different components of the system interact with each other.  The fact that **Thakur** may teach that the communication is carried out prior to a purchase does not change the fact that **McClung** teaches that it would have been obvious to one having ordinary skill in the art that the communication can also be carried out after a purchase has been made.  That is to say, the Examiner provided **Thakur** as an additional teaching in order to show that the system used by **McClung**, which is the system found in **Thakur**, would have obviously allowed one having ordinary skill in the art that a consumer can perform a transaction with a vendor, provide the vendor information to a host system, and have the host system be in communication with the vendor in order to monitor any transactions made between the vendor and consumer in the event that a refund or discount is applicable.

Moreover, the above claims recite combinations which only unite old elements with no change in their respective functions and which yield predictable results.  Thus, the claimed subject matter likely would have been obvious under KSR.  In addition, neither applicant's Specification nor applicant's arguments present any evidence that modifying **McClung** with the selected elements of **Thakur** was uniquely challenging or difficult for one of ordinary skill in the art.  Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the combination of **McClung** with the teachings of **Thakur** to provide a system where a consumer can perform a transaction with a vendor, provide the vendor information to a host system, and have the host system be in communication with the vendor in order to monitor any transactions made between the vendor and consumer in the event that a refund or discount is applicable.  Because this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396."

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With that said, it appears to the Examiner that the arguments that are being presented on pages 19 of 22 to 21 of 22 are directed towards **the combination of McClung and Thakur** wherein the applicant argues:

"...**the combination of McClung and Thakur** do not allow one of

ordinary skill in the art to allow a user to provide transaction information to the

host system," and

**Thakur**, "...does not suggest that a user enters any transaction

information but does suggest that the host system automatically

retrieves/receives transaction information."

The Examiner again points out that **Thakur** was not used to teach a user

entering transaction information, but to show that one of ordinary skill in the art would

have realized that a consumer can perform a transaction with a vendor, provide

information to a host system, and have the host system be in communication with the

vendor in order to monitor any transactions made between the vendor and consumer in

the event that a refund or discount is applicable.  Moreover, the Examiner also asserts

that it would have been well within the ability of one having ordinary skill in the art that a

computer based system is fully capable of receiving input and processing that input

regardless of what the input is directed to.  In other words, one of ordinary skill in the art

would have realized that the type of information being transmitted within the system of

**Thakur** is nonfunctional descriptive material and the type of data adds little, if anything,

to the system's structure.

One of ordinary skill in the art would have also realized that it is common

knowledge that computer systems are extremely versatile and that they can be placed

in different environments and communicate with other computers if the computers are

networked.  The Examiner asserts that one of ordinary skill would have realized that the

applicant's invention is no different from the invention disclosed by the combination of

**McClung and Thakur** since all the applicant is doing is providing at least two computer

systems, which are not even claimed, and having them communicate with each other,

as well as taking in input by some user, which is taught by **McClung**, and relaying the

inputted information to the other computer, which is taught by **Thakur**. The fact that the

information is regarding a transaction or a price protection is completely irrelevant, i.e.

nonfunctional. One of ordinary skill in the art would only be concerned whether the two

computer systems are able to receive input from a user, which any computer off the

shelf is fully capable of doing, processing the information and transmitting the

information to another computer, wherein the second computer would process the

received information and transmit any results from the processing back to the first

computer.

  With that said, the Examiner again asserts that anyone having ordinary skill in

the art would have been fully aware that networks of computers do this on a daily basis

and that the only difference is that the applicant is claiming price protection. Looking

upon the **combination of McClung and Thakur** one of ordinary skill in the art would

have taken what is already known about computer networks and found it obvious that

price protection guarantee could be incorporated since all that is being done is

substituting the kind of information that is being transmitted.

  To argue that the, "…**the combination of McClung and Thakur** do not allow

one of ordinary skill in the art to allow a user to provide transaction information to the

host system," is incorrect. Neither **McClung nor Thakur**, separately or in combination,

prevent a user from providing transaction information. As a matter of fact, **at least**

**McClung** clearly discloses that, "The consumer can, via an interactive Internet site (e.g.

of the host system, the vendor, other systems, and/or the manufacturer) provide the

sales and product information to activate the warranty **(McClung Col. 2 Lines 59 – 63)**.

With what has been known in the art at the time of the invention it would have

been well within the skill of one of ordinary skill in the art that providing transaction

information to a host system is very common. Moreover, looking upon the teachings of

the combination of **McClung and Thakur**, wherein the combination discloses price

protection guarantee using a computer network, it would have been very obvious that

transaction information had to have been inputted because the system would never

bother looking for any price protection refunds, as can be seen in at least **McClung Col.**

**2 Lines 59 – 63)**.

In other words, a computer by itself would never be capable of doing anything

unless someone inputs a command to cause the computer to do something. In this

case, it is asserted that a user had to have provided transaction information to the host

system because without this information how would the system ever determine if a user

is entitled to a price guarantee.

Consequently, in response to applicant's arguments against the references

individually, one cannot show nonobviousness by attacking references individually

where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986).  Specifically, regarding applicant's argument regarding

**Thakur** not suggesting a user entering any transaction information, as discussed above.

24.     As best understood by the Examiner the following argument found on **Page 21 of**

**22** pertains to applicant's argument on **Page 15 of 19 of the  Remarks received on**

**February 26, 2008 regarding claims 2, 9, and** 16 where the applicant states, "The

Applicant respectfully suggests that if McClung 'obviously included for the host system

to have a listing text fields and identifiers in order for the user to properly input the

necessary information into the host system' such as information associated with a

product and/or service that was purchased by the user from a second web site then the

Examiner should be able to point out where in McClung this is taught.  However,

nowhere does McClung teach this."

The Examiner responded with the following:

> "The Examiner disagrees that **McClung** requires for such a
> statement to be present in the disclosure of **McClung**.  **35 U.S.C. § 103(a)**
> clearly states:
>
>> (a) A patent may not be obtained though the invention is not identically disclosed or
>> described as set forth in section 102 of this title, if the differences between the subject
>> matter sought to be patented and the prior art are such that the subject matter as a
>> whole would have been obvious at the time the invention was made to a person
>> having ordinary skill in the art to which said subject matter pertains.  Patentability
>> shall not be negatived by the manner in which the invention was made.
>
> Therefore, the Examiner asserts that one having ordinary skill in the
> art would have found it obvious from the teachings **McClung** as well as
> what is commonly known in the art that an online computer system having
> a web site requiring information to be inputted for comparing purposes, for
> example, would obviously have had text fields and identifiers in order for
> the information to be properly compared.  That is to say, it would have
> been obvious that if a consumer wanted to make sure that the Motorola
> cell phone that was purchased for $50.00 would required for the user to
> input the terms "Motorola" and "$50.00" into some type of field in order for
> the computer system to properly store and monitor the correct product and
> price.

In addition, neither applicant's Specification nor applicant's arguments present any evidence that modifying **McClung** uniquely challenging or difficult for one of ordinary skill in the art. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify **McClung** to obviously include for the host system to have a listing text fields and identifiers in order for the user to properly input the necessary information into the host system. Because this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396."

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However, applicant's traversal regarding the Examiner's assertion that, "one having ordinary skill in the art would have found it obvious from the teachings of McClung as well as what is commonly known in the art that an online computer system having a website requiring information to be inputted for comparing purposes, for example, would obviously have had text fields and identifiers for the information to be properly compared" is insufficient.

A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common

knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An

adequate traverse must contain adequate information or argument to create on its face

a reasonable doubt regarding the circumstances justifying Examiner's notice of what is

well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ

231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during

examination, then the object of the well known statement is taken to be admitted prior

art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03

Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of

applicant's failure to adequately traverse, the following are admitted prior art:

> "The method of claim 1, wherein the user interface at the first web site
> includes a web page having a list of text fields and identifiers for the user
> to enter at least one of the following information associated with a
> configuration of a product and/or service that was purchased by the user
> from the second web site, the user thereby providing information directly
> to the first web site:
>> a name of the product and/or service;
>> a description of the product or service;
>> an identifier of the product and/or service;
>> a name, address and telephone number of the second web site;
>> a date the product and/or service was purchased by the user; and
>> a total purchase price the user paid for the product and/or service."

**Dependent Claims**

25.     All rejections made towards the dependent claims with no arguments are

maintained due to the lack of a reply by the applicant in regards to distinctly and

specifically point out the supposed errors in the examiner's action in the prior Office

Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the

dependent claims should be allowable because the independent claims are unobvious

and patentable over **McClung** in view of **Thakur**.


### *Conclusion*

26.     Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Gerardo Araque Jr. whose telephone number is

(571)272-3747.  The examiner can normally be reached on Monday - Friday 8:30AM -

4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Janice Mooneyham can be reached on (571) 272-6805.  The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./
Examiner, Art Unit 3689
11/4/08

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689